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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,304	04/11/2006	Heiko Brunner	B-7228	9543

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EXAMINER

WILLIS, DOUGLAS M

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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07/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,304	Applicant(s) BRUNNER ET AL.	
	Examiner DOUGLAS M. WILLIS	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 11-30 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09-06-06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Claims 1-35 are pending in the current application. According to the *Amendments to the Claims*, filed October 3, 2006, claims 31-35 were added. This application is a 35 U.S.C. § 371 National Stage Filing of International Application No. PCT/EP2004/012851, filed November 9, 2004, which claims priority under 35 U.S.C. § 119(a-d) to DE 10354860.2, filed November 19, 2003.

Status of Priority

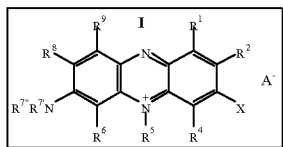
Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a-d), which papers have been placed of record in the file.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. § 119(a-d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this Office action. See 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified English translation may result in no benefit being accorded for the non-English application.

Restrictions / Election of Species

Applicant's provisional election of the following, with traverse, in the reply filed on May



26, 2009, is acknowledged: Group I - claims 1-10 and 31-34.

Affirmation of this election must be made by applicant in replying to this Office action.

The traversal is on the grounds that Groups I and II should be examined simultaneously.

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This is not found persuasive because the multiple inventions in the instant application are independent or distinct for the reasons disclosed in the *Requirement for Restriction / Election of Species*, mailed on April 21, 2009. Furthermore, there would be a serious burden on the examiner if restriction was not required because the inventions have acquired a separate status in the art due to their divergent subject matter and would require a different field of search.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-30 and 35 were withdrawn from further consideration, pursuant to 37 CFR 1.142(b), as being drawn to a nonelected or cancelled invention, there being no allowable generic or linking claim.

Thus, a first Office action on the merits of claims 1-10 and 31-34 is contained within.

Specification Objection - Disclosure

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase *Not Applicable* should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.

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(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art (including information disclosed under 37 CFR 1.97 and 1.98).

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825).

Applicant is advised to format the specification according to 37 CFR 1.77(b) above.

Revisions should particularly include and/or address: a) bold-type, upper case and underline formatting; and b) sections (b-i), where applicable. Appropriate correction is required.

Specification Objection - Title

Applicant is reminded of the proper content of the title of the invention.

The title of the invention should be brief, but technically accurate and descriptive, preferably from two to seven words. See 37 CFR 1.72(a) and MPEP § 606.

The title of the invention is not technically accurate and descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. In the revised title, the examiner suggests identifying: a) the substituted phenazinium salts of the formula I; and b) a particular utility for the substituted phenazinium salts of the formula I.

Claim Objections

Claim 1 is objected to because of the following informalities: a) *general* should be omitted in line 3; b) *carbonic acid ester* should be replaced with *carboxylate ester*; and c) *sulfoester* should be replaced with *sulfonate ester*. Appropriate correction is required.

Claim 7 is objected to because of the following informalities: a) *comprising* should be replaced with *consisting of*; and b) where a claim sets forth a plurality of elements, each element of the claim should be separated by a line indentation {see 37 CFR 1.75(i)}. Appropriate correction is required.

Claim 9 is objected to because of the following informalities: where a claim sets forth a plurality of elements, each element of the claim should be separated by a line indentation {see 37 CFR 1.75(i)}. Appropriate correction is required.

Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. The synthetic methodology employed for the phenazinium salts of claim 1 signifies the onset of a *product-by-process* claim, wherein said claim is not limited to the manipulations of the recited steps, but only by the structure implied by the steps. Consequently, the synthetic methodology employed for the phenazinium salts of claim 1, wherein the phenazinium salts are produced by diazotization, is not found to be further limiting, since the intended synthetic methodology is not given patentable weight. See MPEP § 2111.04 and MPEP § 2113.

Claim 34 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. The synthetic methodology employed for the phenazinium salts of claim 5

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signifies the onset of a *product-by-process* claim, wherein said claim is not limited to the manipulations of the recited steps, but only by the structure implied by the steps. Consequently, the synthetic methodology employed for the phenazinium salts of claim 5, wherein the phenazinium salts are produced by diazotization, is not found to be further limiting, since the intended synthetic methodology is not given patentable weight. See MPEP § 2111.04 and MPEP § 2113.

Claim Rejections - 35 U.S.C. § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Substituted phenazinium salts of the formula I

Claims 1-6, 10, 33 and 34 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7',7'',8,9} \neq -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 \neq$ -heteroaryl, does not reasonably provide enablement for substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7',7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 =$ -heteroaryl. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7',7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 =$ -heteroaryl, as recited in claim 1, have not been adequately enabled in the specification to allow any person having ordinary skill in the art, at the time this invention was

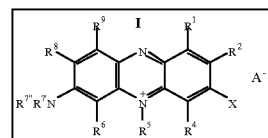
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made, to make and use substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7',7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 = -heteroaryl$.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is *undue*. These factors include, but are not limited to: (a) breadth of the claims; (b) nature of the invention; (c) state of the prior art; (d) level of one of ordinary skill in the art; (e) level of predictability in the art; (f) amount of direction provided by the inventor; (g) existence of working examples; and (h) quantity of experimentation needed to make or use the invention based on the content of the disclosure. {See *Ex parte Forman* 230 USPQ 546 (Bd. Pat. App. & Inter. 1986); and *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988)}.

The above factors, regarding the present invention, are summarized as follows:

- (a) *Breadth of the claims* - the breadth of the claims includes all of the tens of thousands of substituted phenazinium salts of the formula I, shown right;



- (b) *Nature of the invention* - the nature of the invention is synthesis of substituted phenazinium salts of the formula I and the evaluation of these substances as constituents in copper plating baths;
- (c) *State of the prior art* - *US 6,425,996* offers a snapshot of the state of electrolytic deposition of copper coatings in baths. Herein, the addition of organic additives is highlighted (Dahms, W., et al. *US 6,425,996*, **2002**, 1-7);
- (d) *Level of one of ordinary skill in the art* - the artisans synthesizing applicant's substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7',7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 = -heteroaryl$, would be a collaborative team of synthetic chemists, possessing commensurate degree level and/or skill in the art, as well as several years of professional experience;
- (e) *Level of predictability in the art* - Synthetic organic chemistry is quite unpredictable

(See *In re Marzocchi and Horton* 169 USPQ at 367 ¶ 3). The following excerpt is taken from Dörwald, which has extreme relevance to the synthesis of substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7,7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 = -heteroaryl$ (Dörwald, F. Zaragoza. *Side Reactions in Organic Synthesis: A Guide to Successful Synthesis Design*, Weinheim: WILEY-VCH Verlag GmbH & Co. KGaA, 2005, Preface):

Most non-chemists would probably be horrified if they were to learn how many attempted syntheses fail, and how inefficient research chemists are. The ratio of successful to unsuccessful chemical experiments in a normal research laboratory is far below unity, and synthetic research chemists, in the same way as most scientists, spend most of their time working out what went wrong, and why.

Despite the many pitfalls lurking in organic synthesis, most organic chemistry textbooks and research articles do give the impression that organic reactions just proceed smoothly and that the total synthesis of complex natural products, for instance, is maybe a labor-intensive but otherwise undemanding task. In fact, most syntheses of structurally complex natural products are the result of several years of hard work by a team of chemists, with almost every step requiring careful optimization. The final synthesis usually looks quite different from that originally planned, because of unexpected difficulties encountered in the initially chosen synthetic sequence. Only the seasoned practitioner who has experienced for himself the many failures and frustrations which the development (sometimes even the repetition) of a synthesis usually implies will be able to appraise such work.

Chemists tend not to publish negative results, because these are, as opposed to positive results, never definite (and far too copious).

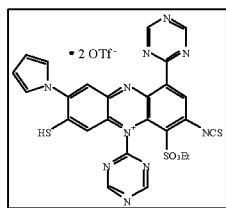
- (f) *Amount of direction provided by the inventor* - the application is negligent regarding direction with respect to making and using substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7,7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 = -heteroaryl$;
- (g) *Existence of working examples* - applicant has provided sufficient guidance to make and use substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7,7'',8,9} \neq -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 \neq -heteroaryl$; however, the disclosure is insufficient to allow extrapolation of the limited examples to enable the scope of the tens of thousands of substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7,7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 = -heteroaryl$. The specification lacks working examples of substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7,7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 = -heteroaryl$.

Within the specification, "specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. *Markush* claims must be provided with support

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in the disclosure for each member of the *Markush* group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.” See MPEP § 608.01(p).

- (h) *Quantity of experimentation needed to make or use the invention based on the content of the disclosure* - Synthetic organic chemistry is quite unpredictable (See *In re Marzocchi and Horton* 169 USPQ at 367 ¶ 3). Furthermore, it is unclear, based



on the guidance provided by the specification, whether a substituted phenazinium salt of the formula I, such as 4-(ethoxy-sulfonyl)-3-isothiocyanato-7-mercapto-8-(1*H*-pyrrol-1-yl)-1,5-di(1,3,5-triazin-2-yl)phenazin-5-ium ditriflate salt, shown to the left, is either synthetically feasible or possesses utility as a constituent in a copper plating bath.

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. {See *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)}.

The determination that *undue experimentation* would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations. (See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404). These factual considerations are discussed comprehensively in MPEP § 2164.08 (scope or breadth of the claims), § 2164.05(a) (nature of the invention and state of the prior art), § 2164.05(b) (level of one of ordinary skill), § 2164.03 (level of predictability in the art and amount of direction provided by the inventor), § 2164.02 (the existence of working examples) and § 2164.06 (quantity of experimentation needed to make or use the invention based on the content of the disclosure).

Based on a preponderance of the evidence presented herein, the conclusion that applicant

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is insufficiently enabled for making and using substituted phenazinium salts of the formula I, where independently $R^{1,2,4,6,7',7'',8,9} = -OH, -CN, -SH, -CO_2H, -CO_2R, -SO_3H, -SO_3R$ or -heteroaryl; and $R^5 = -heteroaryl$, is clearly justified.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-6, 10, 33 and 34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase *the salt thereof*, in claim 1, is a relative phrase which renders the claim indefinite. The phrase *the salt thereof* is not defined by the claims, the specification does not provide an adequate standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification, on page 6, mentions *alkali, earth alkali, aluminum and copper salts*; however, the invention fails to explicitly limit the phrase *the salt thereof* to these specifically disclosed embodiments. Thus, the substituted phenazinium salts of the formula I have been rendered indefinite by the use of the phrase *the salt thereof*.

The examiner suggests removal of the phrase *the salt thereof*, to overcome this rejection.

Claims 1-7, 10 and 31-34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The phrase *an acid anion*, in claim 1, is a relative phrase which renders the claim indefinite. The phrase *an acid anion* is not defined by the claims, the specification does not provide an adequate standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification fails to explicitly limit the phrase *an acid anion*. Thus, the substituted phenazinium salts of the formula I have been rendered indefinite by the use of the phrase *an acid anion*.

The examiner suggests removal of the phrase *an acid anion* and incorporating the limitations of claim 8 (i.e. *chloride, bromide, hydrogen sulfate or tetrafluoroborate*) into claim 1, to overcome this rejection.

Claims 1, 4-6, 10, 33 and 34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term *substituted*, in claim 1, is a relative term which renders the claims indefinite. The term *substituted* is not defined by the claims, the specification does not provide an adequate standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification, on page 6, uses open language, such as *preferably*, to define *substituted*, but fails to explicitly limit the invention to these preferred substituents. Thus, the *substituted* phenazinium salts of the formula I have been rendered indefinite by the use of the term *substituted*.

The examiner suggests removal of the term *substituted* and providing discrete substituents for each occurrence where substituents are desired, to overcome this rejection.

Claim Rejections - 35 U.S.C. § 102

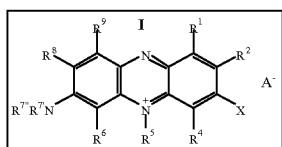
The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 10 and 31-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Motono, et al. in JP 60056086.

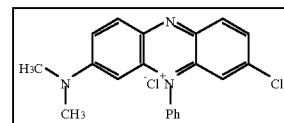
The instant application recites substituted phenazinium salts of the formula I, shown to



the left, where $A^- = Cl^-$; $R^1 = -H$; $R^2 = -H$; $X = -Cl$; $R^4 = -H$; $R^5 = -Ph$; $R^6 = -H$; $R^7 = -CH_3$; $R^{7'} = -CH_3$; $R^8 = -H$; and $R^9 = -H$, as useful in copper

electroplating of baths.

Motono, et al. (JP 60056086), as cited on the IDS, teaches substituted phenazinium salts of the formula I, shown to the right, where $A^- = Cl^-$; $R^1 = -H$; $R^2 = -H$; $X = -Cl$; $R^4 = -H$; $R^5 = -Ph$; $R^6 = -H$; $R^7 = -CH_3$; $R^{7'} = -CH_3$; $R^8 = -H$; and $R^9 = -H$, as useful in copper electroplating of baths [p. 2, Table 1, compound 3].



Claim Rejections - 35 U.S.C. § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

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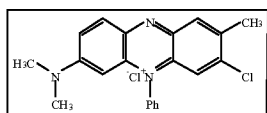
(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10 and 31-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Motono, et al. in JP 60056086.

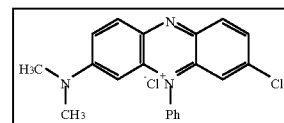
The instant application recites substituted phenazinium salts of the formula I, shown to



the left, where $A^- = Cl^-$; $R^1 = -H$; $R^2 = -CH_3$; $X = -Cl$; $R^4 = -H$; $R^5 = -Ph$; $R^6 = -H$; $R^{7'} = -CH_3$; $R^{7''} = -CH_3$; $R^8 = -H$; and $R^9 = -H$, as useful in

copper electroplating of baths.

Motono, et al. (JP 60056086), as cited on the IDS, teaches substituted phenazinium salts of the formula I, shown to the right, where $A^- = Cl^-$; $R^1 = -H$; $R^2 = -H$; X


$$= -\text{Cl}; \text{R}^4 = -\text{H}; \text{R}^5 = -\text{Ph}; \text{R}^6 = -$$

H; $R^{7'} = -CH_3$; $R^{7''} = -CH_3$; $R^8 = -H$; and $R^9 = -H$, as useful in copper electroplating of baths [p. 2, Table 1, compound 3]. Furthermore, in the genus disclosure,

Motono teaches that R^2 may alternatively be $-\text{CH}_3$ [STN Abstract, shown left, wherein $R^1 = \text{-lower alkyl}$].

The only difference between the instantly recited substituted phenazinium salts of the formula I and Motono's substituted phenazinium salts of the formula I is R^2 is $-\text{CH}_3$ in the instantly recited substituted phenazinium salts of the formula I, whereas R^2 is $-\text{H}$ in Motono's substituted phenazinium salts of the formula I.

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In the chemical arts, it is widely accepted that *structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions or compounds, creates a prima facie case of obviousness.* {See *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, No. 06-1329, slip op. at 9 (Fed. Cir. June 28, 2007) (quoting *In re Dillon*, 919 F.2d 688, 692 [16 USPQ2d 1897] (Fed. Cir. 1990) (en banc)); and *In re Papesch*, 315 F.2d 381 [137 USPQ 43] (C.C.P.A. 1963)}.

Consequently, since: a) Motono teaches substituted phenazinium salts of the formula I, where R^2 is -H; b) Motono teaches substituted phenazinium salts of the formula I, where -H and -CH₃ are alternatively usable at R^2 ; and c) the courts have recognized that *structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions or compounds, creates a prima facie case of obviousness*, one having ordinary skill in the art, at the time this invention was made, would have been motivated to utilize the teachings of Motono and replace the -H at R^2 in Motono's substituted phenazinium salts of the formula I, with an alternatively usable -CH₃, with a reasonable expectation of success and similar utility, rendering claims 1-10 and 31-34 obvious.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claim Rejections - Obviousness-type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute), so as to prevent the unjustified or improper timewise extension of the *right to exclude* granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claims because the examined application claim is either anticipated by, or would have been obvious over, the reference claims. {See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)}.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 and 31-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 10/538,286. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 11 in the copending application recites species, which provide overlapping subject matter with respect to the instant claims. For example, claim 11 of the copending application recites species, namely *3-chloro-7-N,N-dimethylamino-5-phenyl-phenazinium* and *3-chloro-7-N-ethylamino-5-phenyl-phenazinium*, which are homologous with a species in the instant application, namely *3-chloro-7-N,N-dimethylamino-2-methyl-5-phenyl-phenazinium salt*.

MPEP § 2144.09 states *compounds which are homologs, differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups, are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties.* {See *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977)}.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS M. WILLIS, whose telephone number is 571-270-5757. The examiner can normally be reached on Monday thru Thursday from 8:00-6:00 EST.

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The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson, can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOUGLAS M WILLIS/
Examiner, Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner, AU 1624**